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OFFICE OF PETITIONS
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In re Application of :
Victor Firoiu and Marty Borden :
Application No. 09/578,564 :
Filed: May 25, 2000 :
Attorney Docket No. 2204/A05 :

ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed October 17, 2000.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on May 25, 2000 without the filing fees and without an executed oath or declaration and naming Victor Firoiu and Marty Borden as joint inventors.

Accordingly, on August 7, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, the basic filing fee, additional claim fees, and a surcharge for their late filing.

In response, on October 17, 2000 (certificate of mailing date of October 10, 2000), the filing, claim and surcharge fees; a Declaration signed by inventor Firoiu but not

by inventor Borden; the instant petition under 37 CFR 1.47(a) and fee; and declarations by Jeffrey Klayman, Steven Saunders, and John Stickevers in support of the petition under 37 CFR 1.47(a) were received.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.. The instant petition lacks item (1) set forth above.

The petition indicates that a copy of the application papers was mailed to inventor Borden on June 20, 2000 and a reminder letter was mailed on September 12, 2000 at Mr. Borden's home address. Copies of the letters are submitted as evidence in support of this statement. Additionally, on September 22, 2000, petitioner states that an electronic mail message was sent to Mr. Borden. A copy of the electronic mail message accompanies the petition in support this statement.

Petitioner has failed to show or provide adequate proof that a diligent effort was made to reach inventor Borden. The applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor. See MPEP 409.03(a).

The record currently fails to demonstrate, with a documented showing, that a diligent effort was made to reach the nonsigning inventor, such that the declaration can be accepted under 37 CFR 1.47. More specifically, although the petition sets forth the efforts to reach nonsigning inventor Borden, the petition fails to establish whether inventor Borden received the package containing the application papers at the address noted on the transmittal letter. How was the package mailed, i.e., by registered mail, first class mail, etc.? If the package was mailed by registered mail, petitioner should provide a copy of the signed registered mail receipt or any other evidence petitioner may have that would substantiate receipt by nonsigning inventor Borden at the address to which the package containing the application papers was mailed and to demonstrate that the package containing the application was not returned as being undeliverable or an indication that inventor Borden is no longer at that address. Upon receipt of evidence that the package containing the application papers was received by Mr. Borden, it will be concluded that the inactions of nonsigning inventor Borden demonstrate a refusal to join in the application.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-8680.



Frances Hicks
Petitions Examiner
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for Patent Examination Policy